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10/761,132	01/20/2004	Raymond A. Liberatore	10605-1	8784

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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,132

Applicant(s)

LIBERATORE, RAYMOND A.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10-16,19,21-32,34-37 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8, 10-16, 19, 21-32, 34-37 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: sleeve 200; 222 (see figure 23); 267 (see figure 30); 302 (see figure 32). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "202" has been used to designate both inner sleeve (see page 11, figure 23) and ring shaped retainer (see page 10, figure 20). Additionally, reference character "400" has been used to designate both sewn together (see page 13) and inner wall fabric (see page 13). Additionally, reference character "512" has been used to designate both outer fabric wall (see page 14) and donut (see page 14). Additionally, reference character "31" has been used to designate both annular retainer (see page 8) and conical retainer (see page 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

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abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. It is noted that the inner sleeve 202 should be changed to 220.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: frame members 270 (see page 12); foam 406 (see page 13); donut-shaped weight 500 (see page 14). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The use of the trademark SPANDEX or NEOPRENE has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the

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marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The disclosure is objected to because of the following informalities: on page 1, line 17, no clear meaning can be derived from “improvements as respects devices”; on page 6, line 15, “renewal” should be changed to “removal” after “lengthwise”; on page 7, line 1, “sleeve material” should be two words; on page 7, line 15, “continued” should be changed to “contained” after “granules”; on page 8, line 19, “40” should be changed to “40a”, see figure 8); on page 10, line 11, it appears that either “width” or “diameter” should be inserted after “greater”; on page 12, line 10, “Figure” should be deleted after “Figures”. Appropriate correction is required for the above objections.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 5-8, 10-16, 19, 21-32 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as filed does not provide support for the newly claimed limitation in claim 1. The donut shaped weight as shown and described in this application is not associated with a sleeve having retention means. Additionally and by way of example the donut shaped weight has not been shown or described with a plurality of spaced

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apart retention members as required in claim 6, expansion slits as in claim 7, tapered sleeve as in claim 11, a first device as in claim 13 for pulling the sleeve, a second device as in claim 14 for pulling the sleeve. It appears that applicant is claiming broader than has been disclosed. The donut shaped weight as presented is not associated with any of the claimed limitations.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 7, 11, 22, 25 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 7 recites the limitation "the system" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 11 recites the limitation "said associated means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 11 recites the limitation "said inner surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 22 recites the limitation "a sleeve" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 25 recites the limitation "the insert" in line 1. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 30 recites the limitation "the weight or weights" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

17. Claims 1, 5-8, 10-16, 19, 21-30, 32, 34, 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Otten et al (6,533,685).

Regarding claims 1, 5-8, 10-16, 19, 21-25, 27-30, 32, 34 Otten et al shows a sleeve that extends about a bat, the sleeve includes retention means (30) and a donut shaped weight (12) carried on the sleeve. It is noted that the broadest reasonable interpretation of donut shaped weight would include the soft, weighted cylindrical portion 12 of the Otten et al reference (see figures 1-3). As can be seen from the figures, the weight can be carried within an interior pocket formed from the combination of an outer layer and an inner layer. The sleeve and retention means are generally cylindrical in shape and since a bat is generally tapered, the sleeve is also tapered. Otten et al further shows first and second means (40a-c or alternatively element 30 and

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the upper portion of the bat and weight protector 10, which is not identified with a reference character) for pulling the sleeve along the bat. It is clearly disclosed by Otten et al's that the device is to carry weight and to protect a bat, the device includes inner and outer surfaces for forming a pocket for retaining the weight (12) and the retention means (30) best seen in figure 2.

Regarding claim 26, during normal use and operation of the Otten et al device, the method steps set forth by applicant in the claim is inherently provided.

Regarding claims 35-37, see rejection of claims 1, 5-8, 10-16, 19, 21-25, 27-30, 32, 34.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (4,000,893).

Regarding claim 1, Evans discloses an apparatus to add weight to an athletic ball-striking element having a sleeve, the sleeve associated with a retention means and at least one donut shaped weight carried by the sleeve.

Regarding claim 31, Evans further shows the sleeve includes flaps positioned along its length and end portions which are edge connected to form a reduced diameter sleeve section to closely fit about a hitting element (see figures 1-6).

19. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Orchard et al (4,621,808).

Regarding claim 42, Orchard et al discloses a weighting device comprising a donut shaped member having an outer fabric casing, an inner fabric casing and being filled with a flowable material (see figures 1 and 2).



### ***Double Patenting***

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-8, 10-16, 19, 21-25, 27-30-32, 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21, 24-26, 29-31, 33-36 of copending Application No.10/393,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because ‘697 shows a sleeve that extends about a bat, the sleeve includes retention means and a weight or weights carried on the sleeve; the sleeve and retention means are generally cylindrical in shape and are generally tapered, first and second means for pulling the sleeve along the bat; the sleeve is used to carry weight and to protect a bat, the device includes inner and outer surfaces for forming a pocket for retaining the weight or weights and the retention means. Furthermore, ‘697 shows an annular retainer for receiving weight or weights. Additionally, ‘697 shows a method of using the above apparatus. ‘697 does not expressly disclose the annular weights are “donuts”. Examiner takes

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Official Notice of the fact that annular weight or weights are known in the training and sports art to be equivalent to donut-shaped weights for use in the training and sports art. To substitute the annular weight in the '697 reference for the disclosed donut-shaped weight would have been an obvious functional equivalent. It is noted that in the event applicant disagrees that annular weights and donuts are equivalent, then Otten et al '685 clearly shows a donut shaped weight.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

03 January 2006



**MITRA ARYANPOUR**  
**PRIMARY EXAMINER**